

REMARKS

This Amendment is submitted simultaneously with filing of the Request for Reconsideration.

With the present Amendment, applicant amended claims 10 and 15 to more clearly define and to distinguish the present invention from the prior art.

Claim 10, the broadest method claim, defines a method for controlling the scale of a map detail shown on a display unit of a navigation unit, in which, in addition to other features, the scale of the map detail is displayed in such a way that both the current vehicle position and the next decision point located between the current vehicle position and the navigation destination are shown on the display simultaneously.

Claim 15, the broadest apparatus claim, defines a navigation device, in which the control unit is configured so that it sets the scale of the map detail display in such a way that both the current vehicle position and the next decision point located between the current vehicle position and a navigation destination are shown on the display simultaneously, in addition to other features.

In the Office Action and in the Decision on Appeal the claims were rejected over the patent to Koizumi as being anticipated.

Also some claims were rejected over this reference in view of the patent to Takanabe.

It is respectfully submitted that the above listed references, which were applied against the original claims do not teach the new features of the present invention as defined in the amended claims 10 and 15.

As for the anticipation rejection over the patent to Koizumi, it is believed to be advisable to cite the decision in re Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Kazumi does not disclose each and every element of the present invention as defined in claims 10 and 15.

It is therefore respectfully submitted that the anticipation

rejection over the patent to Koizumi should be considered as no longer tenable with respect to the amended claims 10 and 15, and these claims should be considered as patentably distinguishing over the art and should be allowed.

As for the obviousness rejection applied against some claims, none of the references in the proposed combination teaches the new features of the present invention as defined in the amended claims 10 and 15. In order to arrive at the applicant's invention from the proposed combination of the references, the references have to be fundamentally modified, in particular, by including into them the new features of the present invention which are now defined in amended claims 10 and 15.

However, It is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification. This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

There are no hints or suggestions in the references for such

modifications.

In view of the above presented remarks and amendments, it is believed that claims 10 and 15, the broadest claims on file, should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 10, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Any costs involved should be charged to the deposit account of the undersigned (No. 19-4675). Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance,

he is invited to telephone the undersigned (at 212-687-5068).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', with a long horizontal flourish extending to the right.

Michael J. Striker
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